

REMARKS

I. Summary and Clarification of the Office Action Mailed November 27, 2007

In the Office Action mailed November 27, 2007 (the “Office Action”), the Examiner rejected claims 1, 34, and 38-39 on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1-5 of U.S. Patent No. 6,526,981.

Further, the Examiner rejected claims 1 and 34-35 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,257,240 (“Shesol”) in view of U.S. Patent No. 4,237,010 listing Grabenkort *et al.* as inventors. Applicant notes that U.S. Patent No. 4,237,010 lists Zimmerly as the sole inventor (not Grabenkort), and appears to be directed to unrelated technology. However, U.S. Patent No. 5,238,010 lists Grabenkort *et al.* as inventors and is listed by the Examiner in the “Notice of References Cited.” Accordingly, Applicant has proceeded herein as though the Examiner intended to cite U.S. Patent No. 5,238,010 (“Grabenkort”).

The Examiner rejected the remaining claims under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shesol and Grabenkort in view of various other references: claims 31-33 in view of U.S. Patent No. 6,142,966 (“Hely”); claims 36-37 in view of U.S. Patent No. 5,807,300 (“Nix”); and claims 38-39 in view of U.S. Patent No. 6,132,399.

II. Status of the Claims

Claims 1-60 are currently pending, with claims 2-30 and 40-60 having been previously withdrawn from consideration. Claims 1 and 35 have been amended herein. Support for these amendments may be found at least in Figure 19, and in paragraphs [0093] and [0118]-[0119]. No new matter is presented by way of these amendments.

III. Response to the Double Patenting Rejection

Applicant notes that claims 1, 34, and 38-39 stand provisionally rejected as being allegedly unpatentable for non-statutory obviousness-type double patenting over claims 1-5 of U.S. Patent No. 6,526,981. Applicant respectfully submits that upon allowance of the pending claims, Applicant will submit a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c).

IV. Response to the Rejections Under 35 U.S.C. § 103(a)

It is a bedrock principle that all words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A. 1970). The combination of Shesol and Grabenkort does not disclose each and every element of amended claim 1, nor do they otherwise suggest all of its limitations. Therefore, claim 1 is patentable over Shesol and Grabenkort.

Further, if an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988). Accordingly, claims 31-39 are patentable for at least the reason they depend from nonobvious claim 1. Accordingly, Applicant requests that all pending rejections be withdrawn.

In addition, and without conceding the Examiner's arguments regarding any of the dependent claims, Applicant addresses the Examiner's arguments regarding certain dependent claims in greater detail below.

A. *Reliance on Per Se Rules of Obviousness to Reject Claims 32-33 is Improper*

In rejecting claims 32-33, the Examiner relies on the proposition that "mere duplication of essential working parts of a device involves only routine skill in the art," and cites *St. Regis Paper* as alleged support for this statement. Office Action at p. 4-5. Not only does such a general rule of obviousness not exist, but Applicant respectfully submits that the Examiner's reliance on this rule is, without more, both improper and insufficient to support a *prima facie* case of obviousness.

First, the Examiner's reliance on mechanical or *per se* rules of obviousness allegedly established by *St. Regis Paper* is improper. It has been repeatedly held that such *per se* rules do not exist, and that reliance thereon by the examiner to establish obviousness under § 103(a) is improper. See *In re Ochiai*, 71 F.3d 1565, 1570 (Fed. Cir. 1995); and *In re Wright*, 343 F.2d 761, 769-70 (C.C.P.A. 1965). Mere citation of a case for a general obviousness rule is improper, as it sidesteps the fact-intensive inquiry mandated by Section 103. *In re Ochiai*, 71 F.3d at 1570. Accordingly, the Examiner's argument by mere citation to a general principle, and without the proper analysis under Section 103, is insufficient to show the claim is obvious.

Second, *St. Regis Paper* does not stand for the alleged proposition stated by the Examiner, and its holding is otherwise inapposite to the current case. In *St. Regis Paper* – a fact-specific case with a limited holding – the Court of Appeals for the Seventh Circuit held that redundancy of layers to confer strength was obvious in the paper bag art. 549 F.2d 833, 838-39 (7th Cir. 1977). This holding does not support the general proposition for which the Examiner cites the case. Specifically, this holding does not logically support the Examiner’s assertion that it would have been obvious to add another thumbhole adjacent to the first thumbhole. Further, the Examiner has not otherwise provided other evidence to support an obviousness rejection under Section 103. Thus, the Examiner has not shown that the limitations of claims 32-33 would have been obvious to one of ordinary skill in the art, and therefore a *prima facie* case of obviousness does not exist with respect to these claims.

B. Nix Does Not Teach the Required Limitations of Claims 36-37

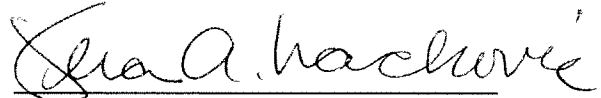
In rejecting claims 36-37, the Examiner states that the combination of Shesol and Grabenkort fails to disclose tubular mesh comprising openings to accommodate various body parts. Office Action at p. 5. The Examiner then alleges that the teachings of Nix regarding a wrap made of tubular mesh are sufficient to overcome the deficiencies of Shesol and Grabenkort. However, Applicant respectfully submits that Nix does not teach all of the additional limitations of claims 36-37.

As noted above, all claim limitations must be considered in determining the patentability of the claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A. 1970). Moreover, all words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Id.* Claim 36 recites that the “tubular mesh comprises at least one opening to accommodate various body parts.” Claim 37 incorporates this limitation of claim 36 and further recites that the tubular mesh comprises “a plurality of openings to accommodate varying sizes of the various body parts.” Nix fails to teach at least these additional limitations. Moreover, no combination of Shesol, Grabenkort, and Nix discloses the additional elements of claims 36 and 37. Accordingly, claims 36 and 37 are further patentable over Shesol, Grabenkort, and Nix.

V. Conclusion

For at least the foregoing reasons, Applicant submits that all pending claims are in condition for allowance and respectfully request notice to that effect. Should the Examiner wish to discuss the case with the undersigned, the Examiner is invited to call the undersigned at 312-701-8115.

Respectfully submitted,

A handwritten signature in cursive script, reading "Vera A. Nackovic", written over a horizontal line.

Vera A. Nackovic
Reg. No. 59,388

Date: April 28, 2008

CUSTOMER NUMBER 26565
MAYER BROWN LLP
P.O. Box 2828
Chicago, Illinois 60690-2828
Telephone: (312) 701-8115
Facsimile: (312) 706-9000